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In re Application of
DALE et al. :
Application No.: 10/521,571
PCT No.: PCT/AU03/00919 :
Int. Filing Date: 17 July 2003 :
Priority Date: 17 July 2002 :
Atty. Docket No.: 21415-0013 :
For: TRANSCRIPTIONAL CONTROL
ELEMENT, CHIMERIC
CONSTRUCTS AND USES
THEREFOR :

DECISION ON PETITION
UNDER
37 CFR 1.181
&
37 CFR 1.137(b)

This decision is issued in response to applicant's "Petition to Withdraw Holding of Abandonment and, in the alternative, Petition to Revive Unintentionally Abandoned Application" filed 14 August 2006.

BACKGROUND

On 17 July 2003, applicant filed international application no. PCT/AU03/00919 which claimed a priority date of 17 July 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 22 January 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 17 January 2005.

On 18 January 2005, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; an application data sheet; and a preliminary amendment.

On 16 May 2005, applicant filed an executed declaration of inventors.

On 08 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) indicating that a sequence listing in compliance with 37 CFR 1.821-1.825 had not been filed. The notification set a two-month time limit in which to respond.

On 13 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the "a copy of sequence listing in computer readable form has been submitted, however, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823." Applicant was required to respond within one month from the date of the notification or within the time remaining in the Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922).

On 08 March 2006, applicant filed "Statement to Support Filing and Submission in accordance with 37 CFR 1.821-1.825."

On 05 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) mailed 08 June 2005 within the time period set therein.

On 14 August 2006, applicant filed "Petition to Withdraw Holding of Abandonment and, in the alternative, Petition to Revive Unintentionally Abandoned Application" which included a submission in accordance with 37 CFR 1.821-1.825.

On 07 September 2006, the PALM Database indicated that a compliant computer readable form (CRF) had been submitted.

DISCUSSION

Petition to Withdraw Holding of Abandonment under 37 CFR 1.181

The above-identified application was abandoned for failure to file a complete response to the Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) mailed 08 June 2005, in that, the sequence listing in computer readable form complying with 37 CFR 1.821-1.825 had not been submitted within the period set therein.

Petitioner states that a response to the Notification Defective Response was filed on 08 March 2006. A review of the application file reveals that the Computer Readable Form filed 08 March 2006 had "detected errors" and was not considered a proper response to the Notification of Defective Response. Since the time-limit to respond to the Notification to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) had elapsed, a Notification of Abandonment was mailed on 05 June 2006.

Further, petitioner states that "if there was a defect in the 08 March 2006 response, applicant should have been given a time limit to respond as per 37 CFR 1.135(c)." Petitioner's argument is incorrect. The Manual of Patent Examining Procedure §714.03,

page 700-231, states that "once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

Therefore, the USPTO was correct in mailing the Notification of Abandonment dated 05 June 2006 and the petition may not be properly granted.

Petition to Revive Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the required sequence listing pursuant to 37 CFR 1.821-1.825.

As to Item (2), the appropriate petition fee of \$750.00 as required by 37 CFR 1.17 will be charged to Deposit Account No. 50-3840.

With regard to Item (3), applicant's statement that "the abandonment was unintentional" does not comply with 37 CFR 1.137(b)(3). However, the statement will be accepted and construed as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, Petitioner is required to provide a statement to that effect.

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

For the reasons above, the petition to withdraw the holding of abandonment under 37 CFR 1.181 is DISMISSED without prejudice.

The petition to revive under 37 CFR 1.137(b) is GRANTED.

This application is being returned to the United States/Elected Office for processing in accordance with this decision.



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